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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,290	12/11/2000	George Bradley Hobbs	10003973-1	3711

22879 7590 06/17/2008  
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INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER
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JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3688

NOTIFICATION DATE	DELIVERY MODE
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06/17/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

Application No.

09/734,290

Applicant(s)

HOBBS, GEORGE BRADLEY

Examiner

JEAN JANVIER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 02/14/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 29-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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### **After The Board Decision**

Prosecution is herein being re-opened after the Board Decision, recorded on 02/14/2008, which reversed the Examiner's Action.

### **Detailed Action**

### **Specification**

### **Status of the claims**

Claims 1-26 and 29-34 are currently being pending, while claims 27, 28 and 35-40 were canceled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 21-26 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satomi, US 2004/0039641 in view of Petrecca, USP 5,781,894.

As per claims 1-10, 21-26 and 29-34, Satomi discloses a terminal apparatus/kiosk (user interface) for obtaining, over a communication link or the Internet, desired information from

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information providers and prints the information in high quality as needed. The terminal adds at least one **advertisement** information to the desired information (print job), which reduces the cost for obtaining and printing the desired information from an information provider over the network or communication link. The terminal calculates the **advertisement** fee by counting the number of printing of the **advertisement**. The terminal charges the user, up to the maximum limit desired, for the information obtained and printed according to the print amount (Reading on defining an information provider system or print processing system controller having or storing therein desired information/content (potential print job) and at least one recorded or registered advertisement, defining a network communication link (an Internet connection) between a customer's interface/terminal and the information provider system or print processing system controller, receiving a request (print job) from a customer for a desired content by the information provider system, wherein the request needs to be processed and printed (processing a job ticket) at the terminal and inserting an advertisement into the printed content). (See abstract; fig. 1 [0026]-[0032]).

In Fig. 6, step S605 displays the preview image received in the step S601, but there may be displayed a preview image in consideration of the output format of the **advertisement** selected by the user in the "**advertisement** setting". In such case, the output format of the **advertisement**, currently selected by the user, is transferred to the CanDINet control unit (print control unit), thereby causing the CanDINet control unit to prepare the preview image data with the **advertisement**. Then such image data are received to display the preview image with **advertisement (at least a preview image of the advertisement is displayed on the user's screen before it is printed together with the printout of the requested content or print job [0 208]).**

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Further, If the "advertisement setting" button [2903] is depressed in the list image shown in FIG. 29 (step S603 --advertisement setting), there is displayed an "advertisement setting" image as shown in FIG. 31 (step S604), and there is executed a process for print charge settling (step S609) [0209]. Here, in the print service, the user pays a print charge, including the service charge, at the printing of the information provided by the information provider 130 of fig. 2. However, if an advertisement is inserted in the print job, then a part of the print charge is being discounted accordingly. The amount of reduction of the print charge varies according to the mode of insertion of the advertisement and the amount thereof [0211-0215]. The type of advertisement inserted into the print job or requested content or printout is based in part on a keyword [0178].

See in general figs. 6, 29-31; [0117-0131]; [0204]; [0208-0209]; [0306]; [0350-0352] and [0358].

As per claims 1, 21, 33 and 34, although Satomi **discloses displaying preview image with advertisement on the user's screen or interface (displaying the ad on the user's or customer's interface) before the print job is printed,** however, Satomi does not expressly disclose displaying the advertisement or ad on the customer's interface (computer screen or display) while receiving or processing the print job.

However, Petrecca discloses an advertising system to be used with personal computers, which enables sponsors to present advertisements or commercials to a user during periods of waiting-time, inherent in normal computer use. A segment of a software product contains one or more sponsors' audio, visual, or multi-modality messages. The advertising system chooses one of

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these messages and presents it to the user of the computer during the times that the user is not normally able to use the keyboard of the computer because information is being loaded up or sent out. **Such times occur during the start-up of a program or during the sending of information from the computer to a peripheral device such as a printer (displaying an ad on the user's interface when a print job is being processed),** modem or fax. The advertisement or sequence of advertisements may be chosen based upon the amount of time, which the computer will need to achieve a task before being ready for new input from the user. The system the user allows to choose to activate an advertising system in return for receiving some type of compensation, which may be used to subsidize the receipt of a service or product, such as a software program (See abstract; figs. 1-3, col. 1: 43-67).

Further, it is common practice in the art to display an advertisement on a user's computer screen while the user's computer is dialing into an ISP system in order to connect to the Internet or during an idle time period as the user is waiting for a requested information or page to be retrieved or downloaded from a web server related to a web site in return for the privilege to receive free or discounted Internet service from the ISP (Internet Service Provider), which uses the revenues, collected from the advertisers to display their advertising content to the user(s), to subsidize the free or discounted service received by the user(s). Furthermore, it is well known in the art to display advertisements to a user's computer screen while the user is waiting for requested information to be retrieved or downloaded from a server related to an accessed web site. It is also customary in the art to allow a user accessing the Internet via an ISP to first read product information or advertising literature before the user is able to access the web for a limited free period of time, wherein revenues collected by the ISP from advertisers are used to

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subsidize the limited and free period of time provided to the user in return for reading or view product information displayed on his screen (no further disclosure is necessary here).

Thus, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the above disclosure (Petrecca and the well recognized practice of displaying an ad on the user's computer during an idle time) into the advertising distribution and printing system of Satomi so as to display an advertisement on the screen of a user's computer upon receiving or while processing the user's print job instead of printing the advertisement along with the user's document associated with the print job especially if the printed document is addressed to a third party, such a prospective employer or recruiter, who should not receive or be exposed to the printed advertisement in the first place, thereby avoiding the embarrassment resulting from knowingly or accidentally printing an advertisement within a page of a document that is addressed to an important third party or VIP, such a prospective employer or a president of a hiring corporation, and efficiently using processing idle time by outputting the advertisement on the user's computer screen, while saving papers, ink and reducing processing time and, hence saving money, by not having to print the advertisement along with the document and while protecting the environment by using less papers and thus, cutting fewer trees, by displaying the advertisement on the user's computer screen (customer's interface) as the user is waiting for the print job or the document to be printed or executed especially if the print queue contains other previously submitted print jobs that should be processed before the user's print job.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Satomi, US 2004/0039641.

As per claims 11-20, Satomi discloses a terminal apparatus/kiosk (user interface) for obtaining, over a communication link or the Internet, desired information from information providers and prints the information in high quality as needed. The terminal adds at least one advertisement information to the desired information (print job), which reduces the cost for obtaining and printing the desired information from an information provider over the network or communication link. The terminal calculates the advertisement fee by counting the number of printing of the advertisement. The terminal charges the user, up to the maximum limit desired, for the information obtained and printed according to the print amount (Reading on defining an information provider system or print processing system controller having or storing therein desired information/content (potential print job) and at least one recorded or registered advertisement, defining a network communication link (an Internet connection) between a customer's interface/terminal and the information provider system or print processing system controller, receiving a request (print job) from a customer for a desired content by the information provider system, wherein the request needs to be processed and printed (processing a



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job ticket) at the terminal and inserting an advertisement into the printed content). (See abstract; fig. 1 [0026]-[0032]).

In Fig. 6, step S605 displays the preview image received in the step S601, but there may be displayed a preview image in consideration of the output format of the advertisement selected by the user in the "advertisement setting". In such case, the output format of the advertisement currently selected by the user, is transferred to the CanDINet control unit (print control unit), thereby causing the CanDINet control unit to prepare the preview image data with the advertisement. Then such image data are received to display the preview image with advertisement (at least a preview image of the advertisement is displayed on the user's screen before it is printed together with the printout of the requested content or print job[0208]).

Further, If the "advertisement setting" button [2903] is depressed in the list image shown in FIG. 29 (step S603 --advertisement setting), there is displayed an "advertisement setting" image as shown in FIG. 31 (step S604), and there is executed a process for print charge settling (step S609) [0209]. Here, in the print service, the user pays a print charge, including the service charge, at the printing of the information provided by the information provider 130 of fig. 2. However, if an advertisement is inserted in the print job, then a part of the print charge is being discounted accordingly. The amount of reduction of the print charge varies according to the mode of insertion of the advertisement and the amount thereof [0211-0215]. The type of advertisement inserted into the print job or requested content or printout is based in part on a keyword [0178].

In short, Satomi anticipates displaying the advertisement, as seen above, on the customer's interface.

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See in general figs. 6, 29-31; [0117-0131]; [0204]; [0208-0209]; [0306]; [0350-0352] and [0358].

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 5,383,129 to Farrell. There is provided a method of estimating cost of printing materials used to print a job on a printing apparatus. The method includes the steps of: storing billing rates reflecting the cost of printing materials to be used in printing the job, selecting a first quantity of printing materials to be used in printing the job, and, prior to printing the job, calculating, as a function of the first selected quantity of printing materials and one of the stored billing rates, a first printing materials cost of the job.

USP 6,025,925 to Davidson discloses an improved printing system having at least one host computer and a printer in which the printer acquires print job accounting information and communicates it to the host computer via NPAP messages. A host computer downloads print job data to the printer through a communications port on the printer (i.e., either a parallel port, serial port, or network port), and as the printer prints the print job that it received from the host computer, the printer temporarily stores job accounting information. At the end of the print job, the printer communicates that job accounting information back to armed host computers via a bi-directional communications port, including typical information such as: the job identifier number, job processing time, number of sheets of paper from each paper source, number of impressions from each paper source (either one-sided or two-sided impressions), the port identifier, the network user name, the name of the print job (as specified), and the printer's serial

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number. Since the data is being accumulated at the printer, rather than at the host computer, there is no estimating by a host-resident program to acquire these statistics, and no database merging (from several host computers) is required to categorize all of the data for one particular printer. Furthermore, the print jobs need not pass through a network queue in order to be detected and accounted for.

USP 5,802,420 to Garr discloses an improved printer that predicts how many pages can be printed before the toner or ink cartridge becomes empty and also predicts how much time remains before this toner or ink cartridge becomes empty. This prediction is based upon the previous printing history of the printer while using this particular toner cartridge. After measuring the quantity of toner left in the toner cartridge, the printer of the present invention will display the approximate quantity of toner remaining in the cartridge on a screen of a host computer that is connected to the printer, either directly or through a network. The monitor screen of the host computer can also display the predicted number of pages remaining, based on the printer's previous usage history as described above. The toner measuring device provides a "level change" output signal when the remaining toner passes through a predetermined gradation threshold, and depending upon the size of the toner cartridge and upon the time and date at which the level change was detected, the predicted number of pages remaining and the actual amount of toner remaining are more accurately updated upon reaching one of these predetermined gradation thresholds. As each gradation level transition occurs, the printer calculates a new value for the "pages per gradation" variable, and also calculates the number of pages that have been printed since the latest cartridge was installed in the printer, the number of pages printed since the last level or gradation change, and the number of pages or sheets printed between the last two level

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changes. The printer also can approximate the amount of toner used in printing a particular page of print media to create a Toner Tally for each printed page, which can be used to judge the amount of toner used for one print job and compare that to the amount of toner used for a second print job. The Toner Tally uses a combination hardware/software counter to count the number of "active" pels of each page for a print job.

USP 5,305,195 to Murphy discloses a method a new system for providing advertising information into an interactive system having a plurality of remotely located terminals. Each terminal includes a video display unit, logic and a video storage medium such as a hard disc in addition to the normal functions of the interactive system of which an ATM is an example. A remote centrally located commercial computer capable of transmitting digitized signals representing commercial offerings and compressed digitized video signals for display on the video unit communicates with each of the remotely located terminals. The compressed digitized video signals are stored on the hard disc of each terminal for display on the video unit at times determined by the use of the terminal. The user selects the services or goods offered by the terminal in the conventional manner. During the waiting time inherent in the operation of the terminal a high quality video advertising message is displayed on the video unit from the hard disc. The message will last for less then 15 seconds and the user selected function will continue at the conclusion of the message. The advertising message will be changed, updated and varied directly from the central computer (See abstract).

USP 6,628,417B1 to Naito discloses a data communication apparatus which serves as a server connected to a predetermined network, comprising: image saving means for saving first image data for display and second image data having a higher resolution than the first image

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data; transmission means for sending the first image data to a client via the network in accordance with a request from the client on the network; reception means for receiving a print request including a print size from the client via the network; calculation means for calculating a size of print image data, which is to be generated from the second image data corresponding to the first image data, on the basis of the print size included in the print request, when the print request is received; processing means for processing the second image data to obtain print image data in accordance with the size calculated by said calculation means; and output means for outputting the print image data obtained by said processing means to predetermined print means (See abstract).

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

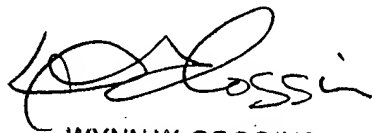
Official Draft : 571-273-8300

06/11/08

/J. J./

/Jean Janvier/

for Jean D. Janvier, Examiner of Art Unit 3688



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